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EXAMINER

RADA, ALEX P

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 04/23/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

Applicant(s)

10/036,092

WHITE ET AL. *ko*

Examiner

Art Unit

Alex P. Rada

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 9. 6) ☐ Other: .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "the plurality" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1-2, 13, 17-18, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett '013.

5. Bennett discloses a gaming apparatus having a plurality of symbols selected from a preselected plurality of different symbols and associating a plurality of pay lines, each having a plurality of designated symbol positions with a randomly generated arrangement, a video monitor, and to enable the replacement of at least one symbol within the displayed arrangement with at least another symbol (wild symbol) as recited in claims 1 and 17; the at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols as recited in claims 2 and 18; and to enable replacement of the at least one symbol (wild symbol) from the position within the displayed arrangement with the at least another symbol responsive to at least one of the following events: generation of at least one preselected symbol for display; generation of at least one predetermined combination of symbols for display; generation of at least one predetermined arrangement of symbols for display; placement of a wager in excess of a preselected threshold; and accumulation of a plurality of selected outcome during prior plays of the game as recited in claim 13 and 29.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 3-7 and 19-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '013 in view of Barrie '384.

8. Bennett discloses the claimed invention as discussed above except for the gaming apparatus is configured to enable interchange of the at least one symbol with the at least another symbol as recited in claims 3 and 19 and the at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols as recited in claims 4 and 20; and to enable at least temporary removal of the at least one symbol from the displayed arrangement, enable movement of the at least another symbol into a position vacated by the at least temporary removal of the at least one symbol, and at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols as recited in claims 5-7 and 21-23.

Barrie teaches a gaming apparatus is configured to enable interchange of the at least one symbol with the at least another symbol as recited in claims 3 and 19 and the at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols, to enable at least temporary removal of the at least one symbol from the displayed arrangement, enable movement of the at least another symbol into a position vacated by the at least temporary removal of the at least one symbol, and at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols (column 5, lines 21 – 60). By interchanging one symbol for another symbol, one of ordinary skill in the art would be able to provide game players with the likely hood of a greater payout. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bennett to include a gaming apparatus is configured to enable interchange of the

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at least one symbol with the at least another symbol as recited in claims 3 and 19 and the at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols, to enable at least temporary removal of the at least one symbol from the displayed arrangement, enable movement of the at least another symbol into a position vacated by the at least temporary removal of the at least one symbol, and at least one symbol having a plurality of symbols and the at least another symbol having a plurality of another symbols as taught by Barrie. To do so would allow game players a chance at a greater payout amount.

9. Claims 8-10 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '013 in view of Bennett '977.

10. Bennett '013 discloses the claimed invention as discussed above except for the replacement of the at least one symbol having visually perceptible movement of the at least one symbol and the at least another symbol within the displayed arrangement and the gaming apparatus is further configured to at least partially constrain the movement of at least one of the at least one symbol and the at least another symbol as recited in claims 8 and 24; the displayed arrangement is configured as a matrix having a plurality of rows and columns of symbols and the movement of the at least one of the at least one symbol and the at least another symbol is constrained with at least one of the following parameters: movement from only one or more specified positions within the displayed arrangement; movement to only one or more specified positions within the displayed arrangement; movement between only one or more specified positions within the displayed arrangement; movement to an adjacent position within the displayed arrangement; direction of movement; movement to a different row; movement to a different column; movement to an opposing side of the displayed arrangement; wraparound

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movement; movement through a selected number of positions within the displayed arrangement; and linked movement of the at least one symbol and the at least another symbol as recited in claims 9 and 25; and the replacement of the at least one symbol with at least another symbol only during a limited period of time as recited in claims 10 and 26.

Bennett '977 teaches the replacement of the at least one symbol having visually perceptible movement of the at least one symbol and the at least another symbol within the displayed arrangement and the gaming apparatus is further configured to at least partially constrain the movement of at least one of the at least one symbol and the at least another symbol, the displayed arrangement is configured as a matrix having a plurality of rows and columns of symbols and the movement of the at least one of the at least one symbol and the at least another symbol is constrained with at least one of the following parameters: movement from only one or more specified positions within the displayed arrangement; movement to only one or more specified positions within the displayed arrangement; movement between only one or more specified positions within the displayed arrangement; movement to an adjacent position within the displayed arrangement; direction of movement; movement to a different row; movement to a different column; movement to an opposing side of the displayed arrangement; wraparound movement; movement through a selected number of positions within the displayed arrangement; and linked movement of the at least one symbol and the at least another symbol, and the replacement of the at least one symbol with at least another symbol only during a limited period of time, in which the examiner interprets to be the penguin traversing through the row and columns in one direction and/or path and changing at least only one symbol all within a predetermined time limit (column 1, line 61 – column 5, line 62). By having partial movement

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constraints, one of ordinary skill in the art would be able to provide game players with the false perception of skill. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bennett '031 to include the replacement of the at least one symbol having visually perceptible movement of the at least one symbol and the at least another symbol within the displayed arrangement and the gaming apparatus is further configured to at least partially constrain the movement of at least one of the at least one symbol and the at least another symbol, the displayed arrangement is configured as a matrix having a plurality of rows and columns of symbols and the movement of the at least one of the at least one symbol and the at least another symbol is constrained with at least one of the following parameters: movement from only one or more specified positions within the displayed arrangement; movement to only one or more specified positions within the displayed arrangement; movement between only one or more specified positions within the displayed arrangement; movement to an adjacent position within the displayed arrangement; direction of movement; movement to a different row; movement to a different column; movement to an opposing side of the displayed arrangement; wraparound movement; movement through a selected number of positions within the displayed arrangement; and linked movement of the at least one symbol and the at least another symbol, and the replacement of the at least one symbol with at least another symbol only during a limited period of time as taught by Bennett '977. To do so would provide game players with an increased outcome.

11. Claims 11-12, 27-28, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '013 in view of Wiltshire '602.



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12. Bennett discloses the claimed invention as discussed above except for the gaming apparatus configured to retrieve the at least another symbol from an exterior source as recited in claims 11 and 27; the exterior source is either a central server or another game device as recited in claims 12 and 28; the central server is configured to randomly generate the at least another symbol for each gaming device responsive to a play of the game as recited in claim 34; and randomly generate the at least another symbol for common use by gaming devices of the plurality during a preselected time period as recited in claim 35.

Wiltshire teaches electronically linked gaming machines which enable information to be transferred between machines and from each machine to a central server using dumb terminals capable of retrieving and generating game data (symbols) information from a central server. By having a central server retrieving or distributing information to a plurality of different gaming devices, one of ordinary skill in the art would be able to provide a low cost gaming stations. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bennett to include gaming apparatus configured to retrieve the at least another symbol from an exterior source, the exterior source is either a central server or another game device, the central server is configured to randomly generate the at least another symbol for each gaming device responsive to a play of the game, and randomly generating the at least another symbol for common use by gaming devices of the plurality during a preselected time period as taught by Wiltshire. To do so would provide a low cost and tamper resistance to individual gaming machines.

13. Claims 14-16 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '031 in view of Payne '607.

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14. Bennett discloses the claimed invention as discussed above except for the gaming apparatus configured to activate a greater number of paylines of the plurality responsive to a greater magnitude of wager place as recited in claims 14 and 30; to permit player selection of one or more paylines to be activated as recited in claims 15 and 31; and to enable player selection of more than one pay line responsive to a wager of more than a preselected minimum wager as recited in claims 16 and 32.

Payne teaches a gaming apparatus configured to activate a greater number of paylines of the plurality responsive to a greater magnitude of wager place, to permit player selection of one or more paylines to be activated, and to enable player selection of more than one pay line responsive to a wager of more than a preselected minimum wager. By activating a number of paylines with the amount wagered, one of ordinary skill in would be able to provide game players with an increased payout. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bennett to include a gaming apparatus configured to activate a greater number of paylines of the plurality responsive to a greater magnitude of wager place, to permit player selection of one or more paylines to be activated, and to enable player selection of more than one pay line responsive to a wager of more than a preselected minimum wager as taught by Payne. To do so would allow game players the ability to choose which paylines to wager for an opportunity at an increased payout.

15. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '013 in view of Wiltshire '602 as applied to claim 33 above, and further in view of Harlick '951.

16. Bennett in view of Wiltshire disclose the claimed invention as discussed above except for enabling a player to discard the at least one symbol and the central server is configured to enable

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another gaming device to retrieve the discarded at least one symbol for replacement of at least one symbol discarded from the another gaming device as recited in claim 36 and the central server configured to enable retrieval of discarded symbols by other gaming device of the plurality in the time order of the gaming apparatus of each gaming device randomly generating an arrangement of symbols as recited in claim 37.

Harlick teaches controlling the operation of electronically linked gaming machine which enable information (symbols) to be transferred between machines and from each machine to a control unit. By having linked gaming machines communicating to each other and a central unit, one of ordinary skill in the art would be able to keep track of information data being distributed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Bennett/Wiltshire to include discarding the at least one symbol and the central server is configured to enable another gaming device to retrieve the discarded at least one symbol for replacement of at least one symbol discarded from the another gaming device and the central server configured to enable retrieval of discarded symbols by other gaming device of the plurality in the time order of the gaming apparatus of each gaming device randomly generating an arrangement of symbols as taught by Harlick. To do so would allow the distribution of data to be controlled and monitored for better efficiency.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Bennett `579 discloses a slot machine having a video display screen, which displays a plurality of rotatable reels carrying symbols arranged to pay a prize on the occurrence of a predetermined symbol or combination of symbols.

Weiss `971 discloses a gaming device and method that allows a primary display and secondary display to be correlated to the extent that symbols of the primary display have vectors, which direct that symbol, associated with each vector onto the secondary display.

Glavich `267, Kaminkow `874, and Baerlocher `645 all disclose a gaming device having wild indicator symbols associated with symbols displayed within a display device on a set of reels.

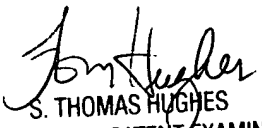
Wain GB `160 and `385 both disclose the interchanging of symbol positions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

APR  
apr  
April 16, 2003

  
S. THOMAS HUGHES  
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